



On October 25, 2001, the Petitioner filed this cancellation proceeding. Petitioner seeks the cancellation of the registration on the claims that Petitioner used its claimed mark OMIC, prior to the filing of Registrant's application for registration, and that there exists a likelihood of confusion.

This proceeding was the subject of numerous extensions of time. By order dated June 30, 2004, the Board set testimony periods that required Petitioner to complete its testimony by September 29, 2004, and Registrant to complete his testimony by November 28, 2004. Petitioner recorded the testimony of its one witness on September 15, 2004, and after an extension of time, filed the transcript of testimony on October 26, 2004.

Registrant filed three motions to enlarge his testimony period. The first requested a thirty-day extension, through December 28, 2004. The second requested an extension through February 28, 2005, and was opposed by Petitioner. Finally, Registrant requested a third enlargement, through April 14, 2005, and was also opposed by Petitioner. At the time that the third request was made, the Board had not ruled on the prior two requests.

Registrant noticed the taking of his testimony and scheduled the testimony within the period of the third requested extension. The taking of Registrant's testimony occurred on March 29, 2005, in ignorance of the fact that the day before, March 28, 2005, the Board had entered its order granting the first two requested extensions, but refusing the third. The Board treated the third request as a motion to reopen, and determined that it should be denied for failure to show excusable neglect.

Registrant immediately moved for reconsideration, requesting that the denial of its last motion for enlargement of its testimony period be reversed and permitting the testimony scheduled and taken in good faith. Petitioner moved to strike Registrant's testimony. In its July

19, 2005, order, the Board rejected the motion for reconsideration and struck the Registrant's testimony.

Registrant requests review and reversal of the Board's orders of March 28, 2005, and July 19, 2005.

## **II. Argument**

In consideration of the nominal impact on the progress of this proceeding resulting from any neglect on the Registrant's part, the substantial prejudice to Registrant's rights should support a finding that the neglect is excusable.

The testimony of the Registrant established that the Registrant first used the subject mark in commerce, by way of shipments in 1990 from a company in the United Kingdom into the United States for distribution here. Thus, if considered on the merits, Petitioner's request for cancellation of the registration of the mark OMIC PLUS must fail, and it is only through disregard of the facts that the Petitioner can prevail.

The Board treated Registrant's third motion for enlargement of time as one to reopen the testimony period, held Registrant to an excusable neglect standard, and found that excusable neglect has not been shown. The Board cited four factors to be considered: (1) the danger of prejudice to the Petitioner, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the Registrant, and (4) whether Registrant acted in good faith. *See Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993). The Board indicated that the third factor is considered the most important. However, as the Board states in its order, these factors are to be included as part of a consideration of all relevant circumstances.

Consideration of the first two factors does not prevent a finding of excusable neglect. In making its ruling, the Board assumed that there was no prejudice to the Petitioner. This is an appropriate assumption, because if considered upon the merits, the petition to cancel the registration was doomed from the beginning. Petitioner can only prevail in its cancellation proceeding when the full facts are disregarded. There are no judicial proceedings that will be affected by delay in this proceeding. In fact, this proceeding was initiated in August 2001, and has been the subject of numerous extensions of time and delays. The additional thirty days needed by the Registrant to preserve his evidence and testimony cannot have had any significant effect. Nor can the third request, technically filed within hours of the expiration of the prior requested extension (which had not at the time been ruled upon) have any significant effect on the proceeding.

As to the fourth factor cited by the Board, nothing in the record impugns the good faith of the Registrant. In fact, the Registrant acted in good faith in procuring the needed evidence and scheduling the taking of his testimony before the Board had ruled on any of his requests for enlargements of time. When the Board denied the third request, Registrant had already noticed the taking of his testimony, and Registrant proceeded with the taking of his sworn testimony without notice that the Board had acted upon his extension requests.

The Board determined that the reasons cited as a basis for the Registrant's third request for enlargement of his testimony period "do not rise to the excusable neglect standard." At the time, however, Registrant was not treating his motion as one to reopen, and did not address the issue of excusable neglect. In his motion for reconsideration, Registrant explained that, in order for the Registrant to produce documentary evidence of his first use of his mark, over 14 years ago, documents had to be obtained from the records of a closed company in the U.K. Registrant

admitted that during the pendency of this proceeding, a lengthy amount of time has been afforded to procure such information, but the delay in the presentation of his testimony has made little difference in the progress of this proceeding, and given the extreme prejudice that results from the disregard of the Registrant's evidence, any neglect on Registrant's part should have been excused in favor of a determination based upon the full facts.

In contrast to this determination, Registrant refers the Petitioner to the recent decision of the Board in another proceeding in which another mark of this Registrant is under attack. Attached to this Petition as Exhibit A is a copy of the Board's order entered July 27, 2005, in *Tecmomed S.R.L. v. Michel Farah*, Opposition No. 91151621. In that proceeding, the Opposer is represented by the same attorney who represents the Petitioner here. In the *Tecmomed* proceeding, the shoe was on the other foot – it was the Petitioner who was asking the Board to reopen its testimony period. The Board's decision, however, reaches a different result based upon a markedly different treatment of the most important of the *Pioneer* factors.

In the *Tecmomed* matter, just as in this proceeding, the Board applied the same four *Pioneer* factors to determine whether the movant had established excusable neglect. As in this proceeding, the Board found that the non-moving party was not prejudiced (the "first factor"). As in this proceeding, the movant requested relief promptly, and did not unduly delay (the "second factor"). And, as in this proceeding, there was no basis for finding that the movant had acted in bad faith (the "fourth factor").

With regard to the third factor, the reason for the delay, the Board found in the *Tecmomed* matter:

... opposer's failure to request an extension of its testimony period within the prescribed time frame was due to circumstances within its control. While the Board can appreciate the disruption caused by the extended absence of opposer's agent, such disruption does not discharge opposer's

obligation to adhere to the set timetable for this case. Moreover, counsel for opposer was aware of the upcoming deadline for the close of testimony, but allowed opposer's testimony period to lapse without taking any testimony or requesting an extension of time. Nonetheless, the Board acknowledges that insofar as counsel for opposer is dealing with a foreign entity, some delay is understandable.

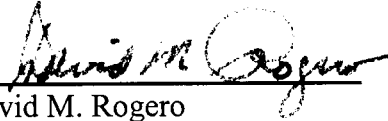
Contrast this with the decision of the Board in the instant matter, where Registrant did not simply let his testimony period lapse, but had motions for enlargement pending, and had noticed the taking of testimony while those motions were pending. It is inexplicable how the Board could excuse the knowing default by Tecmomed, and strike the testimony of Registrant in this case.

As the Board recognized, the *Pioneer* factors for analysis of excusable neglect are to be included as part of a consideration of *all* relevant circumstances. A thorough consideration of the totality of the circumstances here, including the substantial prejudice to the Registrant that results from the striking of his testimony, favors the reversal of the Board's orders and the reopening of testimony to permit the submission of Registrant's testimony taken on March 29, 2005. *See Kohl's Dep't Stores, Inc. v. Levco-Route 46 Assocs., L.P.*, 121 Fed. Appx. 971 (3d Cir. 2005); *Welch & Forbes, Inc. v. Cendant Corp. (In re Cendant Corp. Prides Litig.)*, 235 F.3d 176, 182 (3d Cir. 2000).

To allow consideration of the merits upon a full factual record, will advance the interests of the administration of justice in this proceeding. To let stand the refusal of Registrant's evidence, however, allows a determination contrary to the facts.

Accordingly, Registrant requests that the Petitioner reverse the orders of the Board denying his motion for enlargement of his testimony period and denying his motion for reconsideration, and direct that the testimony period be reopened to permit the submission of Registrant's testimony and evidence.

Respectfully submitted,



David M. Rogero  
Fla. Bar No. 212172  
David M. Rogero, P.A.  
2600 Douglas Road, Suite 600  
Coral Gables, FL 33134  
Telephone: (305) 441-0200  
Fax: (305) 460-4099

Attorney for Registrant Michel Farah

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal

Service with sufficient postage as First-class mail in an envelope addressed to:

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

on August 17, 2005.

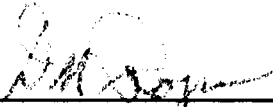


David M. Rogero

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing Petition to Director was sent by first class mail with proper postage affixed, the 7th day of April, 2005, to the following counsel for petitioner:

Donald L. Dennison  
Dennison, Schultz, Dougherty  
1727 King Street, Suite 105  
Alexandria, VA 22314

  
\_\_\_\_\_  
David M. Rogero



# Exhibit A

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Lykos

Mailed: July 27, 2005

Opposition No. 91151621

TECMOMED S.R.L.

v.

FARAH, MICHEL

Before Holtzman, Rogers and Drost, Administrative Trademark Judges.

By the Board:

This case now comes up for opposer's motion (filed May 5, 2005) to reopen its testimony period, and applicant's motion (filed May 24, 2005) for involuntary dismissal pursuant to Trademark Rule 2.132(a). The motions are contested.

On February 2, 2005, opposer filed a motion to extend its testimony period on the grounds that the "principal" of opposer had been out of the country for over four months due to family matters. On March 18, 2005, the Board granted opposer's motion as conceded, and in accordance with opposer's request, reset opposer's testimony period to close April 20, 2005.

Turning to opposer's motion to reopen, opposer contends that the "United States sales agent" for opposer

was abroad for an extended period of time and unable to attend to business in United States; that upon his return, he was overwhelmed with other business matters; that on April 4, 2005, counsel for opposer sent a letter to him regarding a rescheduling of the testimony period which was not answered until May 4, 2005; and that opposer remains interested in pursuing this opposition. In support of its motion, opposer has submitted a copy of the April 4, 2005 letter.

In response, applicant contends that opposer bases its motion to reopen on its sales agent's failure to act in a timely manner; that clearly opposer and its counsel understood the urgency of the approaching deadline; and that opposer offers no reason why it or its counsel, facing a April 20, 2005 deadline, merely sent a letter to opposer's agent and took no further action.

Fed. R. Civ. P. 6(b), made applicable to Board proceedings by Trademark Rule 2.116(a), provides for an enlargement of time after the expiration of the specified time period, "where the failure to act was the result of excusable neglect."

As clarified by the Supreme Court in *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993), and followed by the Board in *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB

1997), the inquiry as to whether a party's neglect is excusable is:

at bottom in an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include. . . [1] the danger of prejudice to the [nonmovant], [2] the length of the delay and its potential impact on judicial proceedings, [3] the reason for the delay, including whether it was within the reasonable control of the movant, and [4] whether the movant acted in good faith.

*Pioneer*, 507 U.S. at 395.

As to the first *Pioneer* factor, i.e., the danger of prejudice to applicant, it does not appear from this record that applicant's ability to defend against opposer's claims has been prejudiced by opposer's failure to adhere to the trial schedule. That is, there has been no showing that any of applicant's witnesses and evidence have become unavailable as a result of the delay in proceedings.

Turning next to the second *Pioneer* factor, i.e., the length of the delay and its potential impact on judicial proceedings, we find that opposer did not unduly delay in filing its motion to reopen. We note that opposer filed its motion to reopen two weeks after the expiration of its testimony period. We further note that applicant, by not responding to opposer's discovery requests in a timely manner, and not filing a motion for involuntary dismissal until after opposer requested a reopening of its testimony

period, does not seem particularly concerned with delay in this case.

Considering next the third *Pioneer* factor, the reason for the delay, the Board finds that opposer's failure to request an extension of its testimony period within the prescribed time frame was due to circumstances within its control. While the Board can appreciate the disruption caused by the extended absence of opposer's agent, such disruption does not discharge opposer's obligation to adhere to the set timetable for this case. Moreover, counsel for opposer was aware of the upcoming deadline for the close of testimony, but allowed opposer's testimony period to lapse without taking any testimony or requesting an extension of time. Nonetheless, the Board acknowledges that insofar as counsel for opposer is dealing with a foreign entity, some delay is understandable.

Finally, under the fourth *Pioneer* factor, there is no basis in this record for finding that opposer's failure to present evidence during its assigned testimony period was the result of bad faith on the part of opposer or its counsel.

Taking into account all the relevant circumstances, and in view of the lack of prejudice to applicant, the brief length of the delay and its minimal impact on this proceeding, and the lack of bad faith on the part of

opposer, we find, on the balance, that excusable neglect has been shown.

In view thereof, opposer's motion to reopen its testimony period is granted, and applicant's motion for involuntary dismissal pursuant to Trademark Rule 2.132(a) is denied as moot.

Nonetheless, the Board reminds opposer that as plaintiff in this proceeding it has a duty to move this case forward in a timely manner. If counsel for opposer is having difficulty obtaining instructions from opposer through its U.S. sales agent, then the Board suggests that counsel deal directly with opposer. **Furthermore, the Board will not approve any additional motions to extend or reopen opposer's main testimony period absent a written stipulation from both parties.**

Proceedings herein are resumed and trial dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close:	10/10/05
30-day testimony period for party in position of defendant to close:	12/09/05
15-day rebuttal testimony period for plaintiff to close:	1/23/06

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served

on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.